

REMARKS/ARGUMENTS

Reconsideration of this application, as amended, is respectfully requested.

1. Rejection of claims 1 – 4, 7 – 14, and 17 – 19 as allegedly obvious under 35 USC 103(a).

The Examiner has rejected claims 1 – 4, 7 – 14, and 17 – 19 as allegedly obvious under 35 USC 103(a), the claims being unpatentable over United States published patent application US 2003/0168451 A1 of Bohrer in view of United States patent 6,394,906 of Hollenbeck. In particular, the Examiner has stated with respect to claim 1 as follows:

“With respect to claim 1, Bohrer discloses a food container with a top and a bottom, being made of transparent polystyrene [0007] and a bottom made of opaque polystyrene[0007], but fails to teach the bottom being foam. Nonetheless, Hollenbeck teaches that a food container made of polystyrene foam so as to provide shock absorption. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to configure the bottom of Bohrer to be made of polystyrene foam as taught by Hollenbeck so as to provide shock absorption.”

With respect to claim 1, the Examiner has acknowledged that Bohrer does not teach a food container with the bottom being foam. The Examiner then notes that Hollenbeck teaches “a food container made of polystyrene foam so as to provide shock absorption.”

The applicant has completely read the specification and claims of the Hollenbeck '906 patent, and has performed an online keyword search of the text of the specification and claims of this patent on the Patent Office website, for the phrase “shock absorption.” The applicant respectfully disagrees that this patent application teaches “a food container made of polystyrene foam so as to provide

shock absorption." The words "shock absorption" do not appear anywhere in the specification or claims of this patent application.

What the Hollenbeck patent does teach is a container having flexible foam construction. In particular, at column 2, lines 19 – 24, there is disclosed,

"The preferred raw materials for preparing the food container/holder of the present invention are flexible urethane polymer foams as particularly disclosed in the Kirk-Othmer Encyclopedia of Chemical Technology, 2nd edition, Vol. 21 (1970), pp. 84-90."

And at column 2, lines 49 – 65, there is disclosed,

"The food container/holder of the present invention has the particular advantage that after being sold to a consumer, the food can be manipulated and advanced incrementally by the consumer as it is eaten.

"In order to consume, for example a hamburger, the resilient catch 12 is released by a user's thumb and the top 6 is swung open. The hamburger within the inside of the bottom 2 and without any other protective covering, is fed out of the bottom by depressing first corrugation 16 followed by depression of corrugation 18, etc. to advance the hamburger being eaten.

"Because of the nature of the flexible polyurethane foam construction of the container, the corrugations compressed by finger pressure will remain collapsed and the partially eaten hamberger [sic] will remain in its advanced position much as a toothpast [sic] tube is compressed to extrude toothpaste."

The applicant respectfully submits that if the Bohrer were to make his food container with the polymer foam bottom being of a flexible urethane polymer foam as recited in Hollenbeck, the Bohrer container would be rendered unsuitable for its intended purpose. In paragraph [0002] of the '451 patent application, Bohrer teaches,

"One-piece lidded containers (e.g., domed or clamshell containers) are commonly used in supermarkets and other food stores to package salads, muffins, prepared foods and the like. The containers are formed by thermoforming a length of thermoplastic material to provide

a bottom tray having a container structure and top tray having a corresponding lid (e.g., dome) structure. The bottom and top trays are connected by a portion of the thermoplastic material that acts a living hinge."

And in reference to Figure 2, Bohrer states in paragraph [0017],

"FIG. 2 is a side elevational view of the thermoplastic starting sheet shown in FIG. 1 having container and lid or dome structures thermoformed on the non-overlapping sections of the starting sheet."

It is clear from the disclosure of Bohrer that he is providing a domed or clamshell container, and that the intended use is for "supermarkets and other food stores to package salads, muffins, prepared foods and the like." In such an intended use, it is very common for such containers that are filled with prepared foods to be placed in a chilled but open display case that has sufficient depth so as to be able to stack such containers on top of each others at least several deep. This is commonly done to conserve space and minimize refrigeration energy costs. The containers often contain dense, wet foods such as potato salad, and are quite heavy. The food container of Bohrer thus must have sufficient structural strength to allow filling the container with dense foods and stacking them without collapsing. The domed shape of the bottom and the top portions of the container taught by Bohrer are so shaped in order to meet this requirement as well as providing volume for the food.

The applicant respectfully submits that if the Bohrer were to make his food container with a polymer foam bottom being of a flexible urethane polymer foam as recited in Hollenbeck, the Bohrer container would be rendered unsuitable for its intended purpose. With such a flexible bottom portion, it would not have the

structural strength required for the desired stacked arrangement in a supermarket display.

Furthermore, it is clear that the container of Hollenbeck is a relatively small container, as Hollenbeck describes its operation in one hand of a user to dispense its contents. However, the container of Bohrer is commonly provided in a considerably larger size, such as about ten inches long and wide by several inches deep. Such a container would be extremely flexible if it were made with the bottom of Bohrer, and would not be suitable for the rough handling of groceries that often occurs after purchase. Groceries are typically placed in bags in a haphazard manner, loaded in a vehicle, transported, unloaded, and taken to a kitchen. Sturdy containers are required to withstand such rough handling. The container of Bohrer with a flexible foam bottom as disclosed by Hollenbeck would be unsuitable for such a purpose.

The applicant also respectfully submits that if the applicant were to make his food container as recited in claim 1, with the polymer foam bottom being of a flexible urethane polymer foam as recited in Hollenbeck, the applicant's container would also be unsuitable for its intended purpose, for the same reasons as described above.

The applicant concedes that the bottom portion of the container of the Hollenbeck '906 patent is made of polymer foam. However, in order to make a proper rejection of the applicant's claims under 35 USC 103(a), as being unpatentable over United States published patent application US 2003/0168451 A1 of Bohrer in view of United States patent 6,394,906 of Hollenbeck, the

motivation to combine these references must come from the references themselves, and not the applicant's disclosure. MPEP § 2143 states:

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations). The teachings or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure. *In re Vaeck*, 947, F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The applicant respectfully submits that the mere fact that the Bohrer food container might be modified by including the bottom portion of the Hollenbeck container is not enough to make such modification obvious without more. The applicant respectfully submits that two of the three basic criteria for an obviousness rejection under 35 USC 103(a) have not been met.

With regard to the first criterion, before prior art references can be combined or modified, there must be some suggestion or motivation in the art to make the combination or modification. *In re Dance*, 160 F.3d 1339, 1343 (Fed. Cir. 1998); *Heidelberger Druckmaschinen v. Hantscho Commercial*, 21 F.3d 1068, 1072 (Fed. Cir. 1994); *In re Geiger*, 815 F. 2d 686,688 (Fed. Cir. 1987); *Lindemann Maschinenfabrik v. Am. Hoist and Derrick*, 730 F.2d 1452, 1462 (Fed. Cir. 1984). "It is insufficient to establish obviousness that the separate elements of the invention existed in the prior art, absent some teaching or suggestion, in the prior art, to combine the elements." *Arkie Lures v. Gene Larew Tackle, Inc.*, 119 F.3d953,957 (Fed. Cir. 1997).

The applicant respectfully submits that there is no suggestion or motivation provided by the references to make any such modification to produce the claimed invention. In fact, there is the opposite. The Hollenbeck patent teaches a foam bottom with a high degree of flexibility, while the applicant's container clearly must have a rigid bottom with sufficient structural strength to hold substantial quantities of wet, dense food. Where the prior art leads away from a particular combination or modification, this is strong evidence of non-obviousness. *Monarch Knitting Machinery v. Sulzer Morat GmbH*, 139 F.3d. 877,882 (Fed. Cir. 1998); *In re Geisler*, 116 F.3d. 1465, 1471 (Fed. Cir. 1997); *Kloster Steedsteel AB v. Crucible Inc.*, 793 F. 2d. 1565, 1573 (Fed. Cir. 1986).

Additionally, the following is stated in MPEP 2143.01, V. "THE PROPOSED MODIFICATION CANNOT RENDER THE PRIOR ART UNSATISFACTORY FOR ITS INTENDED PURPOSE:"

If the proposed modification would render the prior art invention being modified unsuitable for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F. 2d 900, 21 USPQ 1125 (Fed. Cir. 1984).

The applicant respectfully submits that this is the case, as has been explained on pp. 3 – 5 of this Response.

With regard to the second criterion, it is respectfully submitted that without any showing, suggestion, or motivation to combine the cited references, there can be no reasonable expectation of success. Furthermore, even if one were to combine the references as proposed by the Examiner in his rejection, one would not have a reasonable expectation that the container would function successfully. To the contrary, for the reasons described on pp. 4 – 5 of this Response, one

would have the expectation that the container would not have the requisite structural strength for its intended use, and would be unsuccessful.

It is respectfully submitted that absent these two criteria, the Examiner's rejection under 35 USC 103(a) is improper and should be withdrawn. It is also respectfully submitted that claim 1 is allowable.

It is further respectfully submitted that since claims 2 – 4, claims 7 – 14, and claims 17 - 19, being dependent upon claim 1 which is allowable, are also all allowable.

2. Rejection of claim 6 as allegedly obvious under 35 USC 103(a).

The Examiner has rejected claim 6 as allegedly obvious under 35 USC 103(a), the claims being unpatentable over United States published patent application US 2003/0168451 A1 of Bohrer in view of United States patent 6,394,906 of Hollenbeck, and in further view of United States patent 3,937,389 of Wind.

The applicant respectfully submits that, as in the Examiner's rejection of claims 1 – 4, 7 – 14, and 17 – 19, two of the three basic criteria of a rejection under 35 USC 103(a) have not been met in this rejection. There is no suggestion or motivation provided by the references to make any such modification to produce the claimed invention, and there is not a reasonable expectation of success if the combination were to be made. The applicant further submits that one would not have a reasonable expectation of success if the combination were made using the preferred material, polyurethane foam, taught by Hollenbeck. Since polyurethane foams are generally thermoset foams, they are poorly suited

to being joined to a thermoset polymer such as polystyrene via a fusion-based joining process such as heat sealing recited in claim 6.

The applicant submits the same arguments as recited with regard to claim 1 under Item 1. The applicant respectfully submits that as claim 6 is dependent upon claim 1, which is allowable, claim 6 is also now allowable.

3. Rejection of claim 5 as allegedly obvious under 35 USC 103(a).

The Examiner has rejected claim 5 as allegedly obvious under 35 USC 103(a), the claims being unpatentable over United States published patent application US 2003/0168451 A1 of Bohrer in view of United States patent 6,394,906 of Hollenbeck, and in further view of United States patent 6,193,090 of Connors et al.

The applicant again respectfully submits that, as in the Examiner's rejection of claims 1 – 4, 7 – 14, and 17 – 19, two of the three basic criteria of a rejection under 35 USC 103(a) have not been met in this rejection. There is no suggestion or motivation provided by the references to make any such modification to produce the claimed invention, and there is not a reasonable expectation of success if the combination were to be made. As stated in the above arguments with respect to the rejection of claim 6, the applicant further submits that one would not have a reasonable expectation of success if the combination were made using the preferred material, polyurethane foam, taught by Hollenbeck. Since polyurethane foams are generally thermoset foams, they are poorly suited to being joined to a thermoset polymer such as polystyrene via a fusion-based joining process such as ultrasonic welding recited in claim 5.

The applicant submits the same arguments as recited with regard to claim 1 under Item 1. The applicant respectfully submits that as claim 5 is dependent upon claim 1, which is allowable, claim 5 is also now allowable.

4. Rejection of claims 15 and 16 as allegedly obvious under 35 USC 103(a).

The Examiner has rejected claims 15 and 16 as allegedly obvious under 35 USC 103(a), the claims being unpatentable over United States published patent application US 2003/0168451 A1 of Bohrer in view of United States patent 6,394,906 of Hollenbeck, and in further view of United States patent 5,046,659 of Warburton.

The applicant again respectfully submits that none of the three basic criteria of a rejection under 35 USC 103(a) have been met in this rejection. There is no suggestion or motivation provided by the references to make any such modification to produce the claimed invention, and there is not a reasonable expectation of success if the combination were to be made. The applicant submits the same arguments as recited with regard to claim 1 under Item 1. The applicant respectfully submits that as claims 15 and 16 are dependent upon claim 1, which is allowable, claims 15 and 16 are also now allowable.

Additionally, the applicant further notes that Warburton does not teach a tab and a hole, but rather a male rib engaging with a female recess. The latching structure of Warburton is not a tab engaging with a hole. Thus the third criterion that the references must teach or suggest all of the claim limitations has not been met as well.

CONCLUSION

In light of the foregoing arguments, the applicant respectfully submits that the Examiner has failed to make a case of prima facie obviousness in his rejections of claims 1 – 19. The applicant respectfully submits that all of claims 1 – 19 are allowable. The applicant respectfully requests reconsideration, and that a timely Notice of Allowance be issued in this case.

If for any reason the Examiner believes that a telephone conference might facilitate the prosecution of this case, he is respectfully requested to call Applicants' agent, John M. Hammond.

Respectfully submitted,

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